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Dated: September 8, 2005 Signature: Donna Forbit
(Donna Forbit)

Docket No.: 51410/P003US/09705003
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Charles L. Dennis

Application No.: 08/997,489

Confirmation No.: 1370

Filed: December 23, 1997

Art Unit: 3627

For: SYSTEM AND METHOD FOR
CONTROLLING FINANCIAL
TRANSACTIONS OVER A WIRELESS
NETWORK

Examiner: A. J. Rudy

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on July 8, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

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|-------|---|
| I. | Real Party In Interest |
| II. | Related Appeals and Interferences |
| III. | Status of Claims |
| IV. | Status of Amendments |
| V. | Summary of Claimed Subject Matter |
| VI. | Grounds of Rejection to be Reviewed on Appeal |
| VII. | Argument |
| VIII. | Claims |
| IX. | Evidence |

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X. Related Proceedings
Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Openwave Systems Inc.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 6 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 1-106, 113-125

2. Claims pending: 107-112

3. Claims rejected: 107-112

C. Claims On Appeal

The claims on appeal are claims 107-112

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed with respect to the present application. Accordingly, the claims enclosed herein as Appendix A are as indicated in the paper filed by Appellants on February 4, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

With regard to claim 107, the claimed subject matter is a method comprising the steps of receiving by a wireless device in communication with a wireless network financial data from a plurality of point of sale locations (page 8, lines 4-12), wherein said financial data relates to customer transactions at said plurality of point of sale locations (page 8, lines 18-29, page 9, lines 1-2), identifying a geographic area to a customer who has initiated a transaction using said wireless device by determining a specific wireless cell that is in communication with said customer's wireless device (page 9, lines 12-28), and determining which of said plurality of point of sale locations are within said geographic area (page 9, lines 12-28); if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer's wireless device over said wireless network (page 10, lines 21-29), and if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area (page 9, lines 29-30, page 10, lines 1-13), and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network (page 10, lines 21-29).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 107-112 are properly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Whether claims 107-112 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Bickham et al. (U.S. Patent No. 5,530,438, hereinafter *Bickham*).

VII. ARGUMENT

A. General

This case has been pending before the United States Patent and Trademark Office for over seven years. Three restriction requirements have been issued. There have been seven Office Actions with no continuations being filed. Two of the previous Office Actions were improperly made Final, and the finality in each case later withdrawn. The Examiner has

asserted rejections against the claims using references that clearly did not constitute prior art. Moreover, there have been long periods of unexplained delay in the examination of this application, for example, from September 2001 to February 2003, a period of 17 months.

The Final Office Action of May 13, 2005 introduced a new ground of rejection against claims 107-112. The Examiner states that the new ground of rejection was necessitated by Appellant's amendment. Office Action, page 3. However, the amendment referred to by the Examiner merely provided antecedent basis for existing claim terms and, therefore, was minor in nature. An Action cannot be made Final where the Examiner introduces a new ground of rejection not necessitated by amendment. *See* M.P.E.P. § 706.07(a). Therefore, Appellant the latest Office Action has *again* been improperly made Final.

In addition, claims 108-112 have not been examined. Appellant has not received a full and fair hearing, and has not had an opportunity to explore the patentability of these claims.

B. Claim Rejections Under 35 U.S.C. § 101

Claims 107-112 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In rejecting these claims, the Examiner's entire argument is that:

"interconnected papers and pencils may be considered a wireless device and network." Final Office Action, page 2 (emphasis added).

First, Appellant respectfully submits that the Examiner's analogy is unjustifiable. Second, The Examiner has not provided any basis for his supposition that a claim is non-statutory if the claimed method can be carried out by *"interconnected papers and pencils."* Appellant does not know of any basis that can support the Examiner's position.

Under section 101,

"[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor...." 35 U.S.C. § 101.

The subject matter of claims 107-112 are processes that comprise using a wireless device in communication with a wireless network to process data. Moreover, the steps of claims 107-112 involve interaction with real world elements (e.g., wireless device, wireless network, wireless cell, point of sale, etc.) and thus the claimed method is not merely the manipulation of an abstract idea or concept. Therefore, Appellant asserts that claims 107-112 clearly fall within the scope of 35 U.S.C. § 101. Accordingly, Appellant respectfully requests that the 35 U.S.C. § 101 rejection of claims 107-112 be withdrawn and that the claims be passed to issuance.

C. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 107-112 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bickham*.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Appellant respectfully asserts that the rejection does not satisfy the basic criteria.

1. Claim 107

a. Lack of All Claimed Limitations

In rejecting claim 107, the Examiner states that:

“Bickham discloses a point of sale system, e.g. 106, a wireless device, e.g. 102, financial transaction data, e.g. 122, a customer, e.g., 118, and a customer local, e.g., 120.” Final Office Action, page 2.

However, the Examiner does not argue that *Bickham* teaches or suggests *any of the steps* recited in claim 107, and Appellant asserts that *Bickham* does not teach or suggest such steps. For example, *Bickham* does not teach or suggest, at least:

“identifying a geographic area to a customer who has initiated a transaction using said wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer’s wireless device; and

determining which of said plurality of point of sale locations are within said geographic area;

if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer’s wireless device over said wireless network; and

if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer’s wireless device over said wireless network.”

Therefore, *Bickham* does not teach or suggest all the claim limitations, and Appellant submits that claim 107 is allowable, at least, for the reasons discussed above.

In addition, the Examiner argues that:

“[T]o have determined a geographic area to the customer would have been obvious to one of ordinary skill in the art.” Final Office Action, page 2.

Appellant respectfully disagrees with the Examiner’s characterization. If the Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is required to produce a reference in support of his position. M.P.E.P. § 2144.03. Accordingly, Appellant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 107 be withdrawn and that the claim be passed to issuance.

b. Lack of Motivation

In arguing that *Bickham* can be modified to meet the elements of claim 107, the Examiner states that that:

“The motivation for [determining the geographic area to the customer] would have been to implement common knowledge technology associated with wireless devices and pinpointing an individuals [sic] position within a [sic] electronic communication system.” Final Office Action, page 2.

It is well settled that the fact that references can be modified is not sufficient to establish a prima facie case of obviousness. M.P.E.P. § 2143.01. The language of the recited motivation

is merely a statement that the reference can be modified, and does not state any desirability for making the modification. Hence, the motivation provided by the Examiner is improper.

There is no suggestion or motivation, either in *Bickham* itself or in the knowledge generally available to one of ordinary skill in the art, to modify *Bickham*. Accordingly, Appellant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 107 be withdrawn and that the claim be passed to issuance.

2. Claims 108-112

Claims 108-112, although indicated as rejected, are not specifically addressed within the body of the Office Action. Final Office Action, pages 2-3.

The Examiner's rejection of claims 108-112, *en masse*, does not comport with Office policy. Appellant respectfully points out that "[i]n accordance with the Patent Law, '[w]henever, on examination, any claim for a patent is rejected, or any objection . . . made', notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given." M.P.E.P. § 707. As such, The Examiner has not "clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." M.P.E.P. § 706. Appellant is entitled to a full and fair hearing. M.P.E.P. § 706.07. Claims 108-112 have not been individually examined. Appellant has not received a full and fair hearing, and has not had an opportunity to explore the patentability of these claims.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Applicant on February 4, 2005.

IX. EVIDENCE

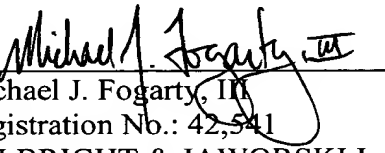
No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

Dated: September 8, 2005

Respectfully submitted,

By 
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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 08/997,489

Claims 1-106 canceled.

107. (Previously Presented) A method comprising the steps of:

receiving, by a wireless device in communication with a wireless network, financial data from a plurality of point of sale locations, wherein said financial data relates to customer transactions at said plurality of point of sale locations;

identifying a geographic area to a customer who has initiated a transaction using said wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer's wireless device; and

determining which of said plurality of point of sale locations are within said geographic area;

if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer's wireless device over said wireless network; and

if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network.

108. (Previously Presented) The method of claim 107 further comprising the steps of:

determining whether said customer has verified said financial data that was communicated to said customer's wireless device.

109. (Previously Presented) The method of claim 107 wherein said prompting step further comprises:

causing said customer's wireless device to display a list of said point of sale locations within said geographic area; and

receiving information from said customer's wireless device identifying said selected point of sale location.

110. (Previously Presented) The method of claim 107 wherein said prompting step further comprises:

playing a voice message to said customers via said wireless device, wherein said voice message comprises a list of said point of sale locations; and

receiving information from said customer's wireless device identifying said selected point of sale location.

111. (Previously Presented) The method of claim 107 wherein said identifying step further comprises the step of:

identifying a specific antenna that is communicating with said customer's wireless device.

112. (Previously Presented) The method of claim 107 wherein said financial data comprises:

product information detected using a bar code scanner coupled to a customer's wireless device.

Claims 113 –125 canceled.

**TRANSMITTAL OF APPEAL BRIEF**Docket No.
51410/P003US/09705003

In re Application of: Charles L. Dennis

Application No.
08/997,489-Conf. #1370Filing Date
December 23, 1997Examiner
A. J. RudyGroup Art Unit
3627

Invention: SYSTEM AND METHOD FOR CONTROLLING FINANCIAL TRANSACTIONS OVER A WIRELESS NETWORK

TO THE COMMISSIONER OF PATENTS:Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: July 8, 2005The fee for filing this Appeal Brief is \$ 500.00☒ Large Entity☐ Small Entity☐ A petition for extension of time is also enclosed.

The fee for the extension of time is _____

☐ A check in the amount of _____ is enclosed.☒ Charge the amount of the fee to Deposit Account No. 06-2380
This sheet is submitted in duplicate.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 06-2380
This sheet is submitted in duplicate.

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Dated: September 8, 2005**Appeal Brief Transmittal**

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Dated: September 8, 2005

Signature: Donna Forbit (Donna Forbit)